

REMARKS

In the February 5, 2007 Office Action, claims 1-15 and 17-20 stand rejected in view of prior art, while claim 16 was indicated as containing allowable subject matter. No other objections or rejections were made in the Office Action.

Status of Claims and Amendments

In response to the February 5, 2007 Office Action, Applicants have amended claim 16 as indicated above to accept allowable subject matter. Applicants wish to thank the Examiner for this indication of allowable subject matter and the thorough examination of this application. Thus, claims 1-20 are pending, with claims 1, 16 and 17 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

Rejections - 35 U.S.C. § 103

In paragraphs 2 and 3 of the Office Action, claims 1-15 and 17-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,902,503 to Nanko (hereinafter "Nanko patent") in view of DE Patent No. 4340471 to Butz (hereinafter "Butz patent"). In response, Applicants respectfully traverse this rejection in view of the following comments.

First, the subject application was filed after November 29, 1999. Second, the Nanko patent would only qualify as prior art under 35 U.S.C. §102(e). Third, the present application and the Nanko patent were commonly owned at the time the present invention was made. Thus, prior art (Nanko patent) that was commonly owned and based on 35 U.S.C. §102(e) is now disqualified as prior art against the claimed invention under 35 U.S.C. §103(a).

Statement Concerning Common Ownership

Application No. 10/786,153 and the Nanko patent (U.S. Patent No. 6,902,503) were, at the time the invention of Application No. 10/786,153 was made, owned by, or subject to an obligation of assignment to Shimano Inc.

Accordingly, Applicants believe that claims 1-15 and 17-20 of the above-identified patent application are patentable under 35 U.S.C. §103(c), because the Nanko patent is *disqualified* as prior art. See also MPEP §§706.02(1)(1) and 706.02(1)(2). Accordingly, withdrawal of this rejection is respectfully requested.

Furthermore, arrangements of independent claims 1 and 17 are *not* disclosed or suggested by the Butz patent or any other prior art of record. Currently under U.S. patent law that the mere fact that the prior art can be modified does *not* make the modification obvious, unless the prior art *suggests* the desirability of the modification. Accordingly, the prior art of record lacks any suggestion or expectation of success for combining the patents to create the Applicants' unique arrangement of a motorized front derailleur mounting member or a motorized front derailleur assembly.

Moreover, Applicants believe that dependent claims 2-15 and 18-20 are also allowable over the prior art of record in that they depend from independent claims 1 and 17, and therefore are allowable for the reasons stated above. Also, the dependent claims are further allowable because they include additional limitations. Thus, Applicants believe that since the prior art of record does not disclose or suggest the invention as set forth in independent claims 1 and 17, the prior art of record also fails to disclose or suggest the inventions as set forth in the dependent claims.

Appl. No. 10/786,153
Amendment dated May 24, 2007
Reply to Office Action of February 5, 2007

Therefore, Applicants respectfully request that this rejection be withdrawn in view of the above comments.

Allowable Subject Matter

In paragraph 4 of the Office Action, claim 16 was indicated as containing allowable subject matter. Applicants wish to thank the Examiner for this indication of allowable subject matter and the thorough examination of this application. In response, Applicants have amended claim 16 to place it in independent form. Thus, independent claim 16 is believed to be allowable.

Prior Art Citation

In the Office Action, additional prior art references were made of record. Applicants believe that these references do not render the claimed invention obvious.

* * *

In view of the foregoing amendment and comments, Applicants respectfully assert that claims 1-20 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,

/David L. Tarnoff /
David L. Tarnoff
Reg. No. 32,383

GLOBAL IP COUNSELORS, LLP
1233 Twentieth Street, NW, Suite 700
Washington, DC 20036
(202)-293-0444
Dated: 05/24/2007

S:\05-MAY07-MLB\SN-US045010 Amendment.doc